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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,857	03/28/2001	Jean Prevost	1912-0243P	1638

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EXAMINER

BAHTA, ABRAHAM

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 06/19/2002

*[Handwritten signature]*

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/818,857

Applicant(s)

PREVOST ET AL.

Examiner

Abraham Bahta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to an article, classified in class 428, subclass 17.
- II. Claim 18, drawn to a method, classified in class 156, subclass 60.

The inventions are distinct, each from the other because:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the a baseball warning track may be made by providing only small granules of sand.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Joe McKinney on 05/15/02 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claim 18 has been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Prevost (USP 5,958,527).

Prevost teaches a synthetic grass playing surface comprising a backing, a large number of upstanding synthetic ribbons from the backing, and an infill layer of particulate material placed among the synthetic ribbons. The reference teaches the infill material may be resilient granules such as rubber, vermiculite, cork, foam plastic, black, cryogenically ground rubber or colored EPDM rubber. See col. 5, line 17- col. 6, line 39 and col. 7, lines 8-13. The granules materials of Prevost are known to have a characteristic of being non-marking when a ball comes in contact with the granules. The infill layer is made of a base course, a middle course and a top course. The

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base course is substantially of hard sand granules disposed immediately upon the top surface of the backing. The middle course is of intermixed hard sand granules and resilient rubber granules. The top course is substantially of resilient rubber granules. See col. 5, lines 35-48.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prevost '527.

As discussed above, Prevost teaches the present claimed invention except the length of ribbon which project above the infill layer; however, since the reference at col. 4, lines 45-52 teaches that depending on the sport or other expected use of the surface, the upper portion of the synthetic ribbon may extend upwardly from the top surface of the top course from 0.25 to 1.00 inches to give the appearance of grass blades and control the rolling of balls during play and that by also modifying the thickness and density of the grass ribbon blades extending through the top surface, the rolling characteristic of a ball in play can be modified, it would have been obvious to one of

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ordinary skill in the art at the time of the invention was made to modify the length of the ribbons depending on the ultimate use of the playing surface as suggested by Prevost.

***Claim Rejections - 35 USC § 103***

Claims 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prevost '527.

As discussed above, Prevost teaches applicants claimed invention except fails to mention a second surface area that acts as a warning track; however, since Prevost teaches a synthetic grass playing surface comprising a base course, a middle course and a top course and that courses comprise different granules materials, for example the top course mainly comprise of rubber granular material and the middle course comprises of intermixed hard sand and rubber granules and the base course comprises mainly of sand granules which obviously have different tangible properties because of their characteristics, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to arrange the difference courses or layers in such a way that when a player steps on the playing surface, for example on the surface having sand particles, the player may be exposed to abrasion or spray of sand.

Regarding claim 10, the reference teaches the sand, rubber and have different thickness or size relative to one another. See col. 6, line 49-col. 7, line 18.

Regarding claim 11-15, selecting contrasting color and alternating color tones arranged in a checkered pattern is merely a matter of design choice which would have been obvious to the skilled artisan for aesthetic reasons.

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Regarding, claim 17 forming the synthetic grass into sections and attaching the sections together in individual panels involves only routine skill in the art.

Any inquiry concerning this communication should be directed to Abraham Bahta at telephone number (703) 308-4412. The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Deborah, Jones, can be reached on (703) 308-3822.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



A. Bahta

06/14/02

  
DEBORAH JONES

SUPERVISORY PATENT EXAMINER